

### **REMARKS**

Claims 40-55 are pending in the above application. By the above amendment, claims 53-55 have been added.

The Office Action dated May 22, 2006, has been received and carefully reviewed. In that Office Action, claims 40-52 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claims 40-47 and 49-52 were rejected under 35 U.S.C. 102(e) as being anticipated by Shaw. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Acres. Each of the issues raised in the Office Action is addressed below, and reconsideration and allowance of claims 40-55 is respectfully requested in view of the following remarks.

### **STATEMENT OF SUBSTANCE OF INTERVIEW**

Applicant left a telephone message for the examiner on June 4, 2006, requesting clarification of certain statements contained in the Office Action. The examiner returned this call on June 6, 2006. During the telephone discussion, the examiner confirmed that the rejection of claims 40-47 and 49-52 should have been based on Shaw, and that Shaw and not Judson should have been listed in paragraph 10 of the Office Action. Applicant also requested clarification regarding two parts of the rejection which appeared to be ambiguous. In response to a first request, the examiner indicated that he was interpreting the portion of Shaw's email application that connects to the Internet as the "application" required by the pending claims. The examiner also indicated that the PDL notation referred to, for example, at column 14 of Shaw, was being interpreted as the claimed "additional data to be acted on by the application." The telephone call was only for the purpose of obtaining clarification of statements made in the Office Action; no arguments were presented and no claims were discussed beyond the general discussion described above.

### **REJECTIONS UNDER 35 U.S.C. 112, FIRST PARAGRAPH**

Claims 40-52 are rejected under 35 U.S.C. 112, first paragraph, as including limitations that are not supported by the specification. It is respectfully submitted that the specification, at,

for example, page 29, line 29 to page 32 line 30, provides support for each limitation mentioned in this rejection. The specific rejections are addressed below.

Claim 40 is rejected under 35 U.S.C. 112, first paragraph, because the Office Action finds no support in the specification for the claimed limitation, “while the application is terminated, receiving and saving additional data to be operated on by the application and additional advertising data.” Page 29, line 32 to page 30, line 2, describe the termination of an application, in this embodiment, a game program. Page 30, lines 3-4 discuss, after terminating the application, removing a storage medium and mounting it on a terminal. The receipt and saving of additional data to be acted on by the application and additional advertising data is discussed at page 30, line 12-20.

Claim 47 is rejected under 35 U.S.C. 112, first paragraph, because an information receiving unit for receiving, when a processor is not running an application, additional data to be acted upon by the application and additional advertising data is allegedly not disclosed. It is respectfully submitted that terminal 200, discussed at page 30, lines 12-20 is one example of a disclosed information receiving unit. These lines of the specification also discuss the receipt of additional data and additional advertising data.

Claim 52 is rejected under 35 U.S.C. 112, first paragraph, because the limitation “in response to the request to run the application using the additional data to be operated upon by the application and before running the application, displaying an advertisement based on the additional advertising data; and running the application using the additional data to be acted on by the application” is allegedly not supported by the specification. Page 32, lines 6-22 describe steps that occur when a user wants to use an application, in this case a game. When the game is turned on, an advertisement is displayed. The application is then run using the additional data, which in one embodiment is additional information about a character or pet being controlled by a user.

It is noted that new claim 53 requires that the additional information not be advertising information or formatting for advertising information. The above portion of the specification also provides support for this new claim.

It is respectfully submitted that the above specific cites to portions of the specification

together with a reading of page 29, line 29 to page 32, line 30, would enable one of ordinary skill in the relevant art to practice the claimed invention. The withdrawal of the rejections of claims 40-52 under 35 U.S.C. 112, first paragraph, is therefore respectfully requested.

REJECTIONS UNDER 35 U.S.C. 102(b)

Claim 40 is rejected under 35 U.S.C. 102(b) as being anticipated by Shaw. Claim 40 requires a method of presenting advertising that includes, *inter alia*, running an application using data to be acted on by the application, terminating the application, and while the application is terminated, receiving and saving additional data to be operated on by the application and additional advertising data.

The only application disclosed in Shaw is an email client. If Shaw's email client is terminated, nothing in Shaw suggests that additional data or advertising information is received. Shaw therefore does not show at least this step of the claimed invention, and claim 40 is submitted to be allowable over Shaw for at least this reason.

During the telephone interview, the examiner indicated that he was interpreting the portion of Shaw's email program that connects to the internet as corresponding to the claimed application. Applicant reserves the right to challenge this interpretation of the term "application." However, even if the portion of Shaw's email application that connects to the internet is taken to correspond to the claimed application, Shaw does not anticipate claim 40. Claim 40 requires that while the application is terminated, information be received and stored. After Shaw's internet connection subroutine connects to the internet, receives mail and disconnects, that the subroutine is terminated. However, nothing in Shaw suggests that any information, much less additional information and additional advertising data is received at that time. Information only appears to be received and saved while the email client is connected to the internet, e.g. while the connection subroutine is running and not terminated as required by claim 40.

In addition, claim 40 requires a step of running "the application" using "additional data to be acted on by the application." If "the application" is taken to mean Shaw's internet connection subroutine and the "additional data" is interpreted as PDL formatting data, the application does

not use the additional data as required by this claim. Therefore, even under the interpretation of claim 40 used by the Office Action, claim 40 is submitted to be allowable over Shaw.

If this rejection is maintained, it is respectfully requested that the examiner provide an additional explanation of either 1) how Shaw's device is believed to receive additional data while the claimed application is terminated or 2) how Shaw's internet connection routine uses additional data as required by claim 40. The clarification of this issue would help determine whether further claim amendments would be helpful or whether a Notice of Appeal is needed.

Claims 41-46 depend from claim 41 and are submitted to be allowable over Shaw for at least the same reasons as claim 40. In addition, claim 41 requires a display of an advertisement based on a display of additional data in response to a request to run an application using additional data to be acted on by the application. If the "application" is being interpreted as the internet connection portion of Shaw's email application, this internet connection subroutine does not use additional data as required by claim 41. Claim 41 is submitted to further distinguish over Shaw for this reason.

Claim 43 further distinguishes over Shaw by requiring a step of storing an execution result and receiving and saving additional data based on the stored execution result. Nearly all of Shaw's column 7 is cited to support a rejection of this claim, but it is not clear which elements of Shaw are being relied upon. However, it is noted that Shaw records information such as how long a program was used and whether modem problems were encountered. It is possible that this information is being interpreted as an "execution result." Even if this is the interpretation being used, there is no suggestion that additional information is received and saved based on an execution result. Claim 43 is submitted to further distinguish over Shaw for this reason.

Claim 47 is rejected under 35 U.S.C. 102(e) as being anticipated by Shaw. Claim 47 requires an information processing apparatus that includes, *inter alia*, a processor for running an application and an information receiving unit for receiving, when the processor is not running the application, additional data to be acted upon by the application and additional advertising information. The only application disclosed in Shaw is an email application. Shaw in no manner suggests that additional data to be acted upon by this application is received when the processor is not running the application. Claim 47 is submitted to distinguish over Shaw for at least this

reason.

The Office Action has interpreted the portion of Shaw's email program that connects to the internet as the corresponding to the claimed application. However, under this interpretation, additional data would have to be received when the application is not running, e.g. when the email program is not connected to the internet. Nothing in Shaw suggests that information is received when Shaw's email program is not connected to the internet. If the portion of Shaw's program that connects to the internet is interpreted as "the application," then this "application" does not run using the additional data as required by claim 47. Claim 47 is submitted to be allowable over the references of record for at least these reasons. If this rejection is maintained, it is respectfully requested that the examiner explain how a processor in Shaw is being interpreted to receive additional information when at least the portion of Shaw controlling connection to the internet is "terminated," or how an internet connection subroutine acts upon additional data as this phrase is being interpreted.

Claims 48-51 depend from claim 47 and are submitted to be allowable for at least the same reasons as claim 47.

Claim 52 is rejected under 35 U.S.C. 103(a) as being anticipated by Shaw. Claim 52 requires a method of presenting advertising information that includes a step of storing an application. It is not clear what portion of Shaw is being interpreted as corresponding to the claimed application. However, regardless of whether Shaw's email program or a subroutine that connects to the internet is being interpreted as the application, claim 52 is submitted to distinguish over this reference.

If Shaw's email program is being interpreted as the claimed application, Shaw does not show at least a step of, in response to a request to run the application using additional data and, before running the application, displaying an advertisement based on additional data. If Shaw's email program is being interpreted as the application, Shaw does not show 1) an advertisement being displayed based on additional advertising data before the email program is running or 2) a user requesting that the email program be run using additional data before the program is run. One interpretation of "additional data" offered by the examiner is formatting information for controlling the display of an advertisement. It does not appear from Shaw that a user can request

that an email program display an advertisement in a particular format before the email program is run or that the email program will display an advertisement before it is run. For at least these reasons, claim 52 is submitted to be allowable over Shaw.

If the Office Action is interpreting the portion of Shaw's email application that connects to the internet as corresponding to the claimed application, claim 52 still distinguishes over this reference. For example, if the data to be acted on by the application is formatting information for displaying an advertisement, it is does not appear that the subroutine that connects to the internet uses this formatting information. The only information that might be acted on by the internet connection subroutine might be, for example, a telephone number to dial. However, there is no suggestion that Shaw receives "additional data" to be used by this internet connection subroutine. Therefore, claim 52 is submitted to distinguish over Shaw under this interpretation of Shaw as well.

#### NEW CLAIMS

New claim 53 is based on claim 47 but expressly requires that the additional information not comprise advertising information or formatting information for advertising information. The rejections of at least some of the above claims requires an interpretation of the claimed additional information as comprising formatting information for advertising information. It is therefore submitted that claim 53 distinguishes over Shaw.

New claims 54 and 55 correspond to original claims 40 and 47, respectively, but with the added limitation that the additional information not comprise advertising information or formatting information for advertising information as discussed above in connection with claim 53. These claims are submitted to further distinguish over Shaw for the reasons provided above in connection with claim 53.

#### REJECTION UNDER 35 U.S.C. 103(a)

Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Acres. It is respectfully submitted that the Office Action has not explained how Shaw is to be modified in view of Acres or provided a proper motivation for making a modification to Shaw in

view of Acres as provided by MPEP 706.02(j). Therefore, a *prima facie* case of obviousness has not been presented and claim 48 is submitted to be allowable.

First, the Office Action does not explain how Shaw is to be modified in view of Acres. The Office Action merely indicates that the references are to be “combined” in some manner. It is not clear whether Shaw’s email application is to be converted to a game program or whether a game functionality is to be added to Shaw’s email program. The references do not show or suggest how either of these changes to Shaw could be made. Moreover, in view of claim 48 the “data to be acted on by an application” recited in claim 47 would be data to be acted on by a game. It is not clear how the PDL information in Shaw would constitute information to be acted on by a game as would be required under this interpretation. Because the Office Action does not explain what modification to Shaw is proposed, a proper rejection under 35 U.S.C. 103(a) has not been presented, and it is respectfully submitted that claim 48 is allowable over the references of record.

In addition, no motivation for modifying Shaw has been provided. The Office Action cites Acres to show that advertisements can be displayed offline. This already occurs in Shaw. Therefore, Acres provides no benefit that is not already provided by Shaw. In other words, Shaw, suffers from no problem that one skilled in the art would look to Acres to solve. Therefore, one skilled in the art would have no reason to modify Shaw based on the Acres reference. A *prima facie* case of obviousness has not been presented, and claim 48 is submitted to be allowable for this reason as well.

## CONCLUSION

Each issue raised in the Office Action dated May 22, 2006, has been addressed, and it is believed that claims 40-55 are in condition for allowance. Wherefore, reconsideration and allowance of these claims is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Scott Wakeman (Reg. No. 37,750) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No. 10/003,069  
Amendment dated August 22, 2006  
After Final Office Action of May 22, 2006

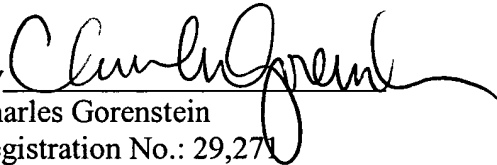
Docket No.: 0033-0778P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: August 22, 2006

Respectfully submitted,

By



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